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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,540	03/01/2004	Hanson S. Gifford III	HRT-0256C2	2779
27777	7590	05/22/2009		
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			EXAMINER COMSTOCK, DAVID C	
			ART UNIT	PAPER NUMBER
			3733	
			MAIL DATE	DELIVERY MODE
			05/22/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/790,540

**Applicant(s)**

GIFFORD ET AL.

**Examiner**

DAVID COMSTOCK

**Art Unit**

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21-38 is/are allowed.
- 6) ☒ Claim(s) 39-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

In view of the arguments presented in the appeal brief filed on 23 February 2009, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing this action.

/Eduardo C. Robert/

Supervisory Patent Examiner, Art Unit 3733

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 39-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Tovey et al. ("Tovey", 5,478,354; cited by Applicant).

Tovey discloses the claimed invention including a device 50 comprising an annular ring 55 and at least two (three are illustrated) equally spaced staple members 52-54 and 56-58 extending therefrom (see, e.g., Figs. 3, 4 and 6 and col. 4, lines 1-21). The ring is disposed about a central axis. Each of the staple members has a distal end. A member, e.g., 69, is configured to be disposed within the ring. The member is movable along the central axis relative to the ring. The device has a first configuration where the member is disposed within the ring (e.g., while installing the ring) and a second configuration where the member is not disposed within the ring (e.g., after installation is complete). The distal ends of the at least two staple members are substantially parallel to the central axis in a first configuration (e.g., Fig. 3) and the distal ends of the at least two staple members are substantially orthogonal to the central axis in a second configuration (e.g., Fig. 6). The device can be formed of a superelastic material such as a shape-memory titanium alloy (see, e.g., col. 2, lines 4-6 and col. 4, lines 27-30). A driver, e.g., 67, is disposed about (i.e. along or near) the member and is movable with respect to the member. The driver is configured to move the ring from a first position relative to the member to a second position relative to the member, whereat the at least two staple members engage tissue.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 46 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tovey et al. ("Tovey", 5,478,354; cited by Applicant).

Tovey discloses the claimed invention except for explicitly reciting that the staple members could extend from an inner periphery of the ring member. However, it would have been obvious to a person having ordinary skill in the art to have configured the device and formed the staple members to extend from an inner periphery of a ring member, e.g., to provide an alternate clamping arrangement, since it has been held that mere relocation of parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. It also would have been obvious to have provided at least four such staple members, e.g., to provide additional clamping force, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

***Response to Arguments***

Applicant's arguments, in the Appeal Brief, filed 23 February 2009, have been fully considered and are persuasive. Therefore the rejection based on the outstanding grounds, i.e., Figs. 8 and 10 of Tovey, has been withdrawn. Basically, Figure 8 is not an annular ring as claimed and Figure 10 does not comprise distal ends of the staple members that are generally parallel to or orthogonal to the central axis in a first or any configuration. It is debatable whether the staple members of the embodiment of Fig. 10 can be seen as extending from a bottom and inner periphery. However, the latter question is moot given the other deficiencies in these embodiments. However, other embodiments show the claimed invention, as described above in the rejection.

#### ***Allowable Subject Matter***

Claims 21-38 are allowable over the prior art of record. While some of independent claim 21 is anticipated by Tovey, the relevant embodiment (e.g., Fig. 3, etc.) of Tovey lacks a member configured to bias (or at least capable of biasing) the distal portions of the at least two staple members to the first configuration when the member is disposed within the ring. While another embodiment (i.e., Figs. 10 and 11) utilizes a configuration wherein a member is configured to bias the staple members to a first configuration, parallel to a central axis, it appears that Tovey et al. require a staple having an undulating shape in connection therewith. The undulating staple does not have a distal portion that is parallel (or orthogonal) to the central axis in any configuration. No other known art discloses or suggests all of the limitations of independent claim 21.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710 (a detailed message should be left if Examiner is unavailable). If attempts to reach the Examiner by telephone or voicemail are unsuccessful, the examiner's supervisor, Eduardo Robert, can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/David Comstock/  
Examiner, Art Unit 3733

/Eduardo C. Robert/  
Supervisory Patent Examiner, Art Unit 3733

